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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/381,286 12/07/99 GROLL

M P564-9039

EXAMINER

HM12/1022

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HARTTER, A

ART UNIT

PAPER NUMBER

1631

DATE MAILED:

10/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/381,286

Applicant(s)

GROLL ET AL.

Examiner

Amy Hartter

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21,22,24 and 27 is/are allowed.
- 6) ☒ Claim(s) 23,25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-14 and 21-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 12.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Attachment to 948 form*.

Final Action

Applicants' arguments, filed 8/2/01, have been fully considered, but they are not deemed to be persuasive. Rejections and/or objections not reiterated from the previous Office Actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application. Therefore please note that claims 21, 22, 24, and 27 are allowed.

Claims 23, 25, and 26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Applicants refer in the specification to a database from which information that is necessary to these claims is obtained. This allows enablement for the claims at the present time but due to the insecurity of the "database market" these technologies could at a future time become unavailable and thus the enablement of the claims would be lost at that time. The patent office continues to require that biological deposits that are required to enable an application of that genre be deposited in an agency such as the ATCC for 30 years or in the case that a patent is obtained for 5 years after the patent has expired. Although the instant situation deals with information and not a biological entity the nature of the situation remains the same. Since the application does not contain any material expression of the database information this enablement rejection is applied. As a reiteration of the conversation on 10/17/01 the Applicants are reminded that this enablement rejection

could be withdrawn if the Applicants cancel the above-mentioned claims and the case at the point would be put in condition for allowance.

This application contains sequence disclosures that are encompassed by the definitions set forth in 37 C.F.R. § 1.821 (a)(1) and (a)(2). See sequences in Drawings.

Failure to comply with these requirements will result in ABANDONMENT of the application under 37 C.F.R. § 1.821(g). For sequence compliance a computer readable form, paper copy for the specification, and a statement under 37 CFR § 1.821(f) are all required. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 C.F.R § 1.136.

This application contains claims 1-14 drawn to an invention nonelected with traverse in Paper No. 8. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Applicant is hereby notified that the required timing for the correction of drawings has changed. See the last 6 lines on the sheet, which is attached, entitled "Attachment for PTO-948 (rev. 03/01 or earlier)". It is noted that a PTO form 948 was mailed with Paper No. 9 on 5/24/01. Applicants are also hereby informed that sequences that fall under the sequence rules which appear in the Drawings or Figures must also SEQ ID Nos. therewith but that these SEQ ID Nos. may be in the Brief Description of the Drawings section in the specification and are not required in the Drawings/Figures per se. Due to the above notification Applicant is required to submit drawing corrections within the time period set for responding to this Office Action. Failure to respond to this

requirement may result in abandonment of the instant application or a notice of a failure to fully respond to this Office Action.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication from this examiner should be directed to Amy Hartter whose telephone number is (703) 305-1696. The examiner can normally be reached M-F from 8:00 to 4:30 p.m. (Eastern Time)

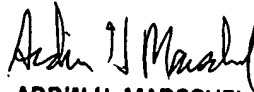
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached at (703) 308-4028. The fax numbers for the group are (703) 308-4242 and (703) 305-3014.

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Any inquiry of a general nature of relating to this application should be directed to the Patent Analyst, Kim Davis, whose telephone number is (703) 305-3015 or to the Technical Center receptionist whose telephone number is (703) 305-308-0196.


Amy Hartter

(703) 305-1696


ARDIN H. MARSCHEL
PRIMARY EXAMINER

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.